



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/658,953	09/10/2003	Alexander Karl Huwig	20959/2140 (P 63469)	3518
7590 Nixon Peabody LLP Clinton Square P.O. Box 31051 Rochester, NY 14603-1051				
EXAMINER				
FUBARA, BLESSING M				
ART UNIT		PAPER NUMBER		
1618				
MAIL DATE		DELIVERY MODE		
06/04/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No. 10/658,953	Applicant(s) HUWIG ET AL.
Examiner BLESSING M. FUBARA	Art Unit 1618

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 20 May 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☒ They present additional claims without canceling a corresponding number of finally rejected claims.
NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☐ Applicant's reply has overcome the following rejection(s): _____.

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1,2,4,11,12,14,15,17-20,27,29 and 30.

Claim(s) withdrawn from consideration: 5-10,13 and 21-26.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:

See Continuation Sheet.

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____

13. ☐ Other: _____.

/Blessing M. Fubara/
Examiner, Art Unit 1618

Continuation of 3. NOTE: New claims 31 and 32 are presented and corresponding number of claims have not been cancelled .

Continuation of 11. does NOT place the application in condition for allowance because: Applicant argues that the rejections of claims 1, 2, 4, 11, 12, 14, 15, 17-20 and 27 under 35 USC should be withdrawn because a pH range of 1-3 finds support in the specification at page 21, lines 23-25 from pH ranges of 1-4, 1.5-3.5 and that the ranges establish points of 1, 1.5, 2, 3, 3.5 and 4. The examiner disagrees because the ranges of 1 to 4, 1.5 to 3.5 and 2-3 disclosed on page 21, lines 23-25 are not representatives of the range of 1-3 and the single points of 1, 1.5, 2, 3, 3.5 and 4 as applicant wants. *Kolmes v. World Fibers Corporation* is not applicable here because at least in the *World* case, a specific point within the disclosed range was described and in the present application, ranges are described, the claimed range was not disclosed and claimed range does not encompass the continuum of points that the disclosed ranges have.

Applicant argues that Example 8 at page 36, lines 31-35 shows that the instant composition results in the formation of massive plugs, but Example 8 uses the composition of Example 5 that is a specific composition different from the composition of claim 1. Applicant has not also factually shown that the composition of Hughes modified as per Asano cannot form massive plugs. Applicant also argues that the composition of Hughes cannot have acidic pH since Hughes discloses the use of acids in combination with metal carbonates and bicarbonates and that Hughes does not disclose compositions which included free acid in combination with a solvent. The comprising language of the claims is open and does not exclude the effervescence generators, carbonates and bicarbonate, and with regards to the pH of the composition of Hughes, applicant has not factually shown that the pH of the composition is basic noting that Hughes contemplates the use of pH adjusting agents.

Applicant argues that Asano is not concerned with desensitizing agents, but Asano and Hughes individually teach mouth wash compositions, the claims are composition claims and applicant's arguments regarding tooth desensitizing is an intended use of the composition; the claims are not directed to method for desensitizing tooth. Applicant is arguing against the references individually, and one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The finally rejected claims are rendered obvious by the combination of Hughes and Asano and applicant's arguments separately attack Asano and Hughes.

Applicant further argues that hindsight reasoning is employed in the rejections, but, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In the present case, Hughes discloses acidic solution but does not specifically teach the recited pH of 1 to 3 and Asano was relied upon for particularly teaching that the dentrifice composition should be maintained at acidic pH to maintain the fluoride in solution. Regarding applicant's arguments that the Examples of Hughes use alkaline reacting compound, it is noted that a prior art reference is not limited to the examples, but the reference as a whole must be evaluated for what it teaches.

Applicant's argument that Asano teaches away from the invention is not persuasive because the claimed invention is a liquid composition and the goal of Asano is to ensure that the fluoride remain in solution. Fluoride ions are not the same as calcium ions; in fact, fluoride is in group VIIA while calcium is a group IVA element with different properties. Asano is clear in column 8, lines 21-26 that formation of precipitate as it relates to fluoride ions is not desired. This does not refer to proteins and calcium and as such Asano does not teach away from the invention .